PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number 042933/274313
(filed with the Notice of Appeal)	

Application Number 09/745,289	Filed December 20, 2000

First Named Inventor Richard D. Romero

Art Unit 2157	Examiner Burgess, Barbara N.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
      Note: No more than five (5) pages may be provided.

Respectfully submitted,

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Attachment

Reasons for Requesting Pre-Appeal Brief Request for Review

Claims 1, 2, 5-14, 16-18, 20-25 and 30-53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ozzie et al. (U.S. Patent No. 6,941,510, hereinafter "Ozzie") in view of Doerre et al. (U.S. Patent No. 6,446,061, hereinafter "Doerre"). Claims 26-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ozzie in view of Doerre and further in view of Shklar et al. (U.S. Patent No. 6,253,239, hereinafter "Shklar"). However, Applicants respectfully request reversal of the rejections above for the reasons provided below.

I. Doerre is not analogous art.

The claimed invention is related to segmenting, transforming and/or viewing electronic documents on devices with limited capabilities. In particular, due to the limited size of a display that is typically associated with such devices, serving of documents for display is often a nontrivial operation. Accordingly, embodiments of the present invention segment the electronic documents into subdocuments which can later be assembled for display in a particular manner. In this regard, for example, independent claim 13 recites, *inter alia*, assembling subdocuments from segments conforming to an algorithm that tends to **balance the respective sizes of the subdocuments**. In other words, as recited, for example, in independent claim 14, the subdocuments are of approximately the same size.

Ozzie is directed to a method for efficient management of XML documents. While Ozzie discloses that main documents may be linked to subdocuments, which may in turn be linked to each other, Ozzie fails to teach or suggest that subdocuments are assembled to be of approximately the same size or of balanced sizes as claimed in the claimed invention. The Office Action admits this deficiency and accordingly cites Doerre as curing the admitted deficiency of Ozzie. However, Doerre is not related to document segmentation at all and, in any case, also fails to cure the deficiency of Ozzie in regard to the feature above.

Doerre is related to "the area of information mining within a multitude of documents stored on a computer system" (Abstract). Thus, as an initial matter, Doerre is not a proper reference for use in combination with Ozzie since Doerre is not analogous art. To rely on a reference under 35 U.S.C. §103, it must be analogous prior art. See MPEP 2141.01(a). The two-

part test for analogous art requires that "the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed.Cir. 2003) (where if the general scope of a reference is outside the pertinent field of endeavor, the reference may still be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

As stated above, the claimed invention is generally directed to segmenting, transforming and/or viewing electronic documents on devices with limited capabilities. Doerre is directed to information mining and, more particularly, to taxonomy (or classification) of documents. As indicated at col. 4, lines 46-52, the taxonomy of the Doerre patent relies upon clustering of similar documents. The problems to be addressed in this art are specifically stated in Doerre. Specifically, Doerre addresses what it identifies as the most important problems in the current state of the art for taxonomy generation including: 1) providing a scalable taxonomy generation tool capable of generating a taxonomy in a reasonable amount of time even for large numbers of documents (col. 4, lines 6-13); and 2) establishing domain independence to speed up taxonomy generation (col. 4, lines 14-18). In other words, Doerre is in the field of taxonomy generation for documents for information mining and the problem addressed is speeding up and improving the generation of the taxonomy of documents.

Taxonomy generation for documents involved in information mining and segmenting, transforming and/or viewing electronic documents on devices with limited capabilities are clearly different fields of invention. Additionally, the problem to be addressed in the present application is serving documents formatted for display on large displays, to devices with much smaller displays, which is clearly different than the stated problems that Doerre is aimed at addressing (as provided above in reference to Doerre's disclosure at col. 4, lines 6-18). Accordingly, Doerre, on the one hand, and the present application, on the other hand, are simply not in the same field of endeavor and Doerre is also not reasonably pertinent to the particular problem with which the inventor was concerned. There would be no reason for one skilled in the art faced with the problem of providing documents formatted for display on large displays, to devices with much smaller displays, to consider a taxonomy generation tool to be pertinent.

Thus, Doerre is not analogous art and, therefore, cannot be relied upon to support an obviousness rejection under 35 U.S.C. §103.

Since Doerre cannot properly be combined with Ozzie or Shklar, it is respectfully submitted that the rejections of all claims based on the combination of these references should be reversed.

II. The cited references, alone or in combination, fail to render independent claims 1 and 13 unpatentable.

Despite the discussion above, even if one assumes for the sake of argument that Doerre is analogous art, the combination of the cited references still fails to teach or suggest the claimed invention as provided in the independent claims. In this regard, Ozzie fails to teach or suggest the assembly of subdocuments to balance the respective sizes of the subdocuments or that the subdocuments are of approximately the same size as provided in the claimed invention, as admitted in the Office Action. However, the Office Action states that Doerre cures the deficiency of Ozzie by virtue of the statement at col. 20, lines 39-40 of Doerre indicating that the size of the leaf nodes is well balanced. As indicated at col. 4, lines 46-52, the taxonomy of Doerre relies upon clustering of similar documents. In this regard, Doerre discloses that a leaf-node is a cluster of documents with the largest similarity (see col. 4, lines 50-52). Accordingly, the disclosure of well balanced leaf nodes at col. 20, lines 39-40, merely indicates that the sizes of the clusters of documents are similar and not that the sizes of any subdocuments are similar. In fact, Doerre is completely unrelated to a hierarchy of sub-documents. Rather, each leaf-node comprises a cluster with roughly a same number of documents and such clusters are comprised of whole documents and not subdocuments as recited in the claimed invention. Although Doerre discloses at col. 17, lines 9-23, that the subset selection process (i.e., selection of a subset of documents for clustering) may be improved if the selection process is performed based on documents of similar size and similar date, such disclosure is only related to documents of the same size and not subdocuments as provided in the claimed invention.

Of note, the final Office Action states that "Doerre teaches information mining clustering to segment a document collection into subsets." The final Office Action then goes on to assert that the "effect of clustering is to segment a document collection into subsets" citing col. 3, lines 6-8, col. 4, lines 39-40 and col. 12, lines 37-39 (see final Office Action page 14). However, the

Examiner's assertions, quoted above as set forth in the final Office Action, actually support the Applicants' position rather than refuting it. In this regard, the Examiner states that a document collection (i.e., not a single document, but a plurality of documents) is segmented into subsets. Thus, even using the Examiner's statements, the result of the segmentation of Doerre is a plurality of whole documents placed into a subset. The subset of Doerre is not a subset of subdocuments, but a subset of documents. Moreover, as stated above, Doerre never segments any documents to form subdocuments at all. Of note, the Examiner never even asserts as much.

However, despite the fact that Doerre is unrelated to segmenting documents into subdocuments, the Examiner still comes to the conclusion that "Doerre, indeed, teaches hierarchy of subdocuments" (see final Office Action page 14). However, the Examiner's conclusion is *non sequitur*, since the clustering of a subset of documents from a collection of documents is in no way suggestive of creating a hierarchy of subdocuments. Subdocuments and subsets of documents are clearly not the same thing. In this regard, even if one assumes that Doerre discloses some form of a hierarchy of documents, the creation of a hierarchy of documents does not suggest, and is not remotely related to, a hierarchy of subdocuments. More importantly, clustering documents, regardless of cluster size, is not suggestive of assembling subdocuments to balance the respective sizes of the subdocuments as provided in the claimed invention. Thus, Doerre fails to teach or suggest the assembly of subdocuments to balance the respective sizes of the subdocuments or that the subdocuments are of approximately the same size as provided in independent claims 13 and 14, respectively. Notably, Shklar also fails to cure the above noted deficiencies and is not cited as such.

Since Ozzie, Doerre and Shklar fail to teach or suggest the assembly of subdocuments to balance the respective sizes of the subdocuments or that the subdocuments are of approximately the same size as provided in independent claims 13 and 14, any combination of the cited references also fails to teach or suggest the above recited features. Independent claims 17, 21, 26, 37-39 and 50 recite similar subject matter to that of independent claim 13 and 14 with respect to the subdocuments being of approximately the same size or balanced with respect to size. Accordingly, all of the independent claims of the present application are patentable over the cited references for at least the same reasons given above with respect to independent claims 13 and 14. Thus the rejections of the independent claims of the present application should be reversed.

III. Conclusion

In conclusion, for all the reasons stated above, independent claims 13, 14, 17, 21, 26, 37-39 and 50 are patentable over the cited references, either alone or in combination. Claims 2, 5-12, 16, 18, 20, 22-25, 27-36, 40-49 and 51-53 depend either directly or indirectly from corresponding ones of independent claims 1, 13, 14, 17, 21, 26, 37-39 and 50 and thus include all the recitations of their corresponding independent claims. Therefore, dependent claims 2, 5-12, 16, 18, 20, 22-25, 27-36, 40-49 and 51-53 are patentable for at least the same reasons given above for independent claims 1, 13, 14, 17, 21, 26, 37-39 and 50.

Accordingly, Applicants respectfully submit that the rejections of claims 1, 2, 5-14, 16-18 and 20-53 should be reversed.